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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/910,809 | 07/24/2001 | Stefano Coccia | 34658/GM/1p | 3939 |

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HOEY, ALISSA L

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| ART UNIT | PAPER NUMBER |
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3765

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/910,809 | Applicant(s) COCCIA, STEFANO | |
| | Examiner Alissa L. Hoey | Art Unit 3765 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 9-14 and 20 -22 are rejected under 35 U.S.C. 102(e) as being anticipated by Garneau (US 6,393,618).

Garneau provides a protective element in a pair of cycling shorts (figures 4 and 6, identifier 10). The protective element comprising a double-stretch support with at least one double-stretch padding connected and the double-stretch padding being arranged at a crotch region of the pair of shorts (column 1, lines 52-56: explaining that the padding support is made out of polyurethane foam. Polyurethane foam is a double – stretch material as supported in Brown (US 6,553,573): column 3, lines 10-61 and The Columbia Encyclopedia, sixth edition: see printout). The double-stretch padding comprising a first central element which is arranged at a tangent to an imaginary curved line of the crotch region of the pair of cycling shorts (figure 2, identifier 20: column 3, lines 12-31). A second element arranged at a front of the crotch region of the pair of cycling shorts (figure 2, identifier 22: column 3, lines 12-31) and a third pair of elements

formed at a rear of the crotch region of the shorts (figure 2, identifiers 26 and 24: column 3, lines 12-31) with first flat regions interposed at transverse ends of the first central element (column 3, lines 12-15). The third elements are mirror-symmetrical with respect to a central plane which is longitudinal to the double-stretch padding and are mutually divided by a second flat region which lies at the longitudinal central plane (figure 2, identifiers 24 and 26: see flat region between pad regions 24 and 26). The support is made out of double-stretch material that can elongate along multiple planes including mutually perpendicular ones (column 3, lines 34-45). The support is connected in the cycling shorts and the padding is applied only at points where resting on a saddle of a bicycle occurs and no padding is provided at any other areas (figure 6). The padding is an open-cell high-density padding (column 2, lines 20-26) The first flat regions, and therefore the dimensions of the first central element, the second element and the third elements are such that they are formed at a folding region of the double-stretch padding that is not affected at the first, second and third elements by any deformation during use (figures 2-6). Further, Garneau provides the seat pad to be held into the shorts in absence of stitched seams (column 3, lines 48-50) and the double-stretch padding having a thickness from 5 to 12 mm (column 2, lines 3-9).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3, 5-8 and 18 are rejected 35 U.S.C. 103(a) as obvious over Garneau (US 6,393,618).

Garneau provides a protective element as described above. However, Garneau fails to teach the elasticity of the support being 30-40% and the density of the padding being between 55 and 95 kg/m³. The cycling shorts and the support being made out of the same material.

It would have been an obvious design choice to have provided the density of the padding material based upon the desired end use of the garment, since one having ordinary skill in the art could determine the density of the padding needed to protect the user.

It would have been further obvious to have provided the cycling shorts of Garneau being the same material as the support padding since, the support padding is made out of a polyurethane material and cycling shorts have been well known to be made out of materials including lycra which is a polyurethane (see The Columbia Encyclopedia, Sixth Edition: print out).

5. Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garneau in view of Speth et al. (US 5,271,101).

Garneau provides a protective element as described above. However, Garneau fails to teach the padding attached to the cycling shorts by high-frequency, thermoformation or ultrasound application methods.

Speth et al. provides protective cycling shorts having a seat pad incorporated therein by the lamination process instead of stitched seams (column 3, lines 42-51)

It would have been obvious to have attached the padded support to the shorts by any means including lamination, ultrasound, thermoformation or high frequency application methods, since all are equivalent securing means are used in place of stitched seams to reduce chafing to the user's body by caused by stitched seams.

It would have been obvious to have provided the protective element of Garneau incorporated into shorts by lamination in place of stitched seams as taught by Speth et al., since stitched seams cause chafing to the user's body that can be prevented by attaching pads to garments using lamination.

Response to Arguments

6. Applicant argues that the examiner states that the Garneau reference does not supply both the shorts of double stretch material and the pad of double stretch material. Applicant further argues that the padding material of Garneau is not taught as elastic and that the combination of "non-elastic layers, i.e. the top and bottom layers of polyester and polyester felt" would cause the combination pad to be non-elastic. While Garneau does teach that the pad is a three layer pad of polyester felt, polyurethane foam and polyester there is no teaching that this combination is non-elastic. What is taught is that the polyester layers are non-compressible. Being that these layers are thin and have air circulation channels in the fabric they must be engineered to have some structural rigidity. However, if these layers were totally inelastic then there would be no padding protection provided. Rather, one using the Garneau pad would be sitting on a

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stack of paper, concrete or wood. This is clearly not the case in what is taught in Garneau. In order for Garneau's pad to function there must be some elasticity in all three layers. Further, to state that the foam material does not have two-way stretch is clearly wrong. It is well established that foam materials stretch in multiple directions and fully recover. Finally, since Applicant does not provide any clear distinctions as to the characteristics of the double stretch material it can be understood that any two way (double stretch) material may be used for each specific section of the garment claimed. Therefore, the layer containing garment of bicycling shorts and the foam based pad of Garneau clearly teaches the invention as claimed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (703) 308-6094. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0758 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

alh
February 29, 2004


JOHN J. CALVERT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700